

### **DETAILED ACTION**

This Office Action is responsive to Applicant's Amendment – After Final Rejection, filed December 9, 2009. As filed, Claims 1-150 are pending; of which Claims 2-150 are withdrawn and Claims 1 & 66-150 are currently amended.

#### ***Response to Amendment***

Applicant's amendments with respect to Claims 1 & 66-150 have been fully considered and are entered. The 103-prior art rejection of Claim 1 has been withdrawn per amendment. As currently amended, the instant claims now recite specific organic compounds for each component of the topical composition (a vasoconstrictor, a penetration enhancer, and a therapeutic agent). As such, Claim 1 is specific and distinct from the prior art, taken alone or as a whole. The closest prior art has been made of record. See US 5,059,603 in Office Action mailed 09/03/09.

#### ***Examination of Elected Species/Group***

As pointed out on pages 4-5 of the Restriction Requirement/Election of Species, mailed May 15, 2009, examination will begin with the elected species. As per MPEP 803.02, if the elected species is found to be unpatentable, the provisional election will be given effect and all other claims to species will be withdrawn from consideration. If the elected species is found to be allowable, the search will be expanded by the Examiner to consider additional species and subgenera within the generic formula until:

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i) an art rejection can be made; ii) the genus claim is found to lack unity of invention; or  
iii) the claims have been searched in their entirety.

The instantly elected species was searched and examined. It was determined that the elected species was free of the prior art. See Office Action mailed September 3, 2009, p. 7. As a result, the search and examination of Claim 1 were expanded within the Markush-type Claim 1 until prior art was found that either anticipated or rendered said claim obvious. As currently amended, Claim 1 has overcome the combined teachings of the prior art. As a result, the search and examination of Claim 1 was further expanded. The claims have been searched in their entirety and no prior art was found; thus, Group I (Claims 1-65) is drawn to an allowable product.

### ***Rejoined Inventions***

Group I (Claims 1-65) is now directed to an allowable product. Pursuant to the procedures set forth in MPEP § 821.04(b), non-elected Group II (Claims 66-150), directed to the process of making or using the allowable product, previously withdrawn from consideration as a result of a restriction requirement, are hereby rejoined and fully examined for patentability under 37 CFR 1.104.

Because a claimed invention previously withdrawn from consideration under 37 CFR 1.142 has been rejoined, the restriction requirement between Groups I & II as set forth in the Office action mailed May 15, 2009 is hereby withdrawn. In view of the withdrawal of the restriction requirement as to the rejoined inventions, applicant(s) are advised that if any claim presented in a continuation or divisional application is

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anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once the restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

### ***Conclusion***

Claims 1-150 are allowed.

### ***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Nolan whose telephone number is (571) 272-4356 and e-mail is [Jason.Nolan@uspto.gov](mailto:Jason.Nolan@uspto.gov). The examiner can normally be reached Monday - Friday (9:00AM - 5:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane, may be contacted at [Joseph.McKane@uspto.gov](mailto:Joseph.McKane@uspto.gov) or (571) 272-0699.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system, (Private PAIR or Public PAIR). Status information for unpublished applications is available through Private PAIR only.

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For information about the PAIR system, see <http://pair-direct.uspto.gov>. For questions on Private PAIR system, contact the Electronic Business Center at (866) 217-9197.

/Jason M. Nolan/

Examiner, Art Unit 1626

/Rebecca L Anderson/

Primary Examiner, Art Unit 1626